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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/808,483

03/25/2004

Hironori Osuga

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EXAMINER

SELLERS, ROBERT E

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

04/22/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/808,483	<b>Applicant(s)</b> OSUGA, HIRONORI	
	<b>Examiner</b> Robert Sellers	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2,4,6,8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2, 8 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

This application contains claims 4 and 6 drawn to an invention non-elected with traverse in the reply filed on May 2, 2006. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144 and MPEP § 821.01).

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor had possession of the claimed invention at the time the application was filed.

Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

1. There is no support on page 7, line 18 to page 8, line 13 as well as in Examples 2, 3 and 5 in Table 1 on page 15 of the specification for the claimed polyorganosiloxane being hydrophilic, nor the composition being “free of hydrophobic silicone compounds.”

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There is no positively recited polyorganosiloxane being either hydrophilic or hydrophobic. The mere absence of a positive recitation is not a basis for an exclusion (MPEP §2173.05(i), *In re Johnson*, 194 USPQ 187, 196, CCPA 1977 and *Ex parte Grasselli*, 231 USPQ 393, Board of Appeals 1983).

The text of section 103(a) of Title 35, U.S. Code not included in this action can be found in the non-Final rejection mailed August 22, 2006.

Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ichiroku et al. Patent No. 6,506,822 in view of Shiobara et al. Patent No. 6,310,120 and Shintai et al. Patent No. 5,362,775.

The rejection is maintained for the reasons of record set forth in the previous Office actions. The arguments filed March 6, 2008 have been considered but are unpersuasive.

2. Ichiroku et al. (col. 2, lines 39-40) discloses a hydrophilic polyoxyalkylene-modified silicone oil within the realm of the claimed polyorganosiloxane (D-ii) according to the instant specification on wherein a silicone oil (page 7, lines 20-21) contains polyether-substituted organic groups (page 8, line 8-9) in an amount of from  $5 \times 10^{-6}$  parts by weight (col. 2, line 39; 5% by weight of (D-ii) per  $1 \times 10^{-4}$  parts by weight of (D)) to 19 parts by weight (95% by weight of (D-ii) per 20 parts by weight of (D)) per 100 parts by weight of epoxy resin (A) and curing agent (B) which includes a phenolic resin (col. 3, lines 35-50). Claims 2 and 8 do not preclude the additional presence of the hydrophobic organopolysiloxane (D-i).

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3. Ichiroku et al. is the primary reference which establishes the use of finely divided silica having a specific surface area of preferably from 100 to 400 m<sup>2</sup>/g in an amount of from 0.1 to 20 parts by weight per 100 parts by weight of the hydrophobic organopolysiloxane (col. 7, lines 2-5) which is less based on the total amount of the composition, thereby embracing the claimed content of from 0.2% to 0.8% by weight.

4. Shiobara et al. (col. 3, line 49) and Shintai et al. (col. 11, lines 22-26) are relied upon as secondary references teaching the efficacy of utilizing the alumina of Ichiroku et al. in spherical form and need not report each and every claim limitation since the primary reference to Ichiroku et al. sets forth the claimed silica proportion range and phenolic resin curing agent. It would have been obvious to employ the alumina of Ichiroku et al. in spherical form as per Shiobara et al. and Shintai et al. in order to reduce the coefficient of expansion and raise the heat conduction.

The amendment necessitated the new ground of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Sellers whose telephone number is (571) 272-1093. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/Robert Sellers/

Robert Sellers  
Primary Examiner  
Division 1796